



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/711,567 | 11/13/2000 | Edward F. Tokas | 031221-058 | 8260 |

21839 7590 02/27/2003

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

KNABLE, GEOFFREY L

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1733

DATE MAILED: 02/27/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,567

Applicant(s)

TOKAS ET AL.

Examiner

Geoffrey L. Knable

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1733

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 84, 85 and 87-89 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suzuki et al. (US 5,137,785).

Suzuki et al. is applied substantially as in the last office action. As to the new requirement that the article is produced under "normal ambient conditions", it is first noted that even if the reference were to suggest performing the metathesis reaction under heated conditions that are higher than claimed (which it is not believed it does as will be noted later), the claims are directed to the product produced by the process, not the process itself, and it is submitted that reasonable basis exists to expect the final product following the reference teachings would be such as to suggest or render obvious that claimed, the burden properly shifting to applicant to conclusively show or establish otherwise. In other words, it would seem reasonable to expect the temperature used to principally impact the reaction rate, not necessarily the final article. Further and in any event, insofar as applicant defines the term "normal ambient conditions" in the specification as inclusive of "for example" temperatures up to about 40⁰ C, the Suzuki et al. reference is considered to be entirely consistent with the conditions claimed as polymerization temperatures of "at least 30⁰ C" are suggested (col. 5, lines 49-50).

Art Unit: 1733

3. Claims 84-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mühlebach et al. (US 5,973,085) taken with Ofstead (US 3,935,179) and Suzuki et al. (US 5,137,785).

These references are applied for the same reasons set forth in the last office action. As to the newly claimed requirement that the article is produced under “normal ambient conditions”, it is first again noted that even if the reference(s) were to suggest performing the metathesis reaction under heated conditions that are higher than claimed (which it is not believed they do as will be noted later), the claims are directed to the product produced by the process, not the process itself, and it is again submitted that reasonable basis exists to expect the final product following the reference teachings would be such as to suggest or render obvious that claimed, the burden properly shifting to applicant to conclusive show or establish otherwise. In other words, it would seem reasonable to expect the temperature used to principally impact the reaction rate, not necessarily the final article (note also col. 51, lines 14-15 of Mühlebach et al.). Further and in any event, note that Mühlebach et al. clearly suggests that the polymerization can take place at room temperature (col. 51, lines 12+) – while this is in the context of use of irradiation at some point in the process, the present claims in no way exclude such polymer systems. Further, Ofstead also clearly suggests polymerization conditions consistent with that claimed – note esp. col. 5, lines 2-6 as well as examples of polymerization at 23°C.

4. Claim 84 rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 5,137,785) or Mühlebach et al. (US 5,973,085) taken with Ofstead (US

3,935,179) and Suzuki et al. (US 5,137,785) as applied above, and further in view of Lesser (US 2,978,354) as applied in the last office action.

5. Applicant's arguments filed 12-23-02 have been fully considered but they are not persuasive.

Applicant's arguments with respect to the newly claimed reaction conditions have been treated within the statement of rejection above. As to Suzuki et al., it is also urged that the reference suggests that the product is formed without "extraneous adhesive", reference being made to col. 2, lines 9-18 of the patent. Again, however, it is the examiner's position that in the laminated article in this reference, it is the metathesis polymer intermediate layer that can be said to be an "adhesive" as it is bonding the adjacent surface layers in the final composite laminate. It is further urged that the Suzuki article is distinguished from that claimed because it is a molded article with bulk polymerized metathesis polymer and not a manufactured article with polymer adhesive as claimed. This argument has been carefully considered but is likewise unpersuasive. The reference clearly suggests a catalyzed metathesis reaction and it is not seen how the present claims define or require anything beyond what is provided in the reference, again considering the intermediate metathesis polymer as an adhesive. In other words, the present claims define a laminate of three layers – two substrates with an interposed polymerized metathesis polymer bonding to the two substrates – this is however exactly what is taught by the reference. While the reference did not refer to the metathesis polymerized material as an "adhesive", it is considered to clearly be functioning in this role.

As to Mühlebach et al., the arguments pertain to the reaction conditions, reference again being made to the statement of rejection in this regard.

As to Ofstead, it is argued that polymerization in bulk or in solution "result in different materials than the manufactured article claimed." It again however is not considered that the present claims define or require any particular polymerization method that in any way defines over that taught in this reference, it being noted again that this reference suggests a *catalyzed metathesis polymer useful as an adhesive*, the claims being directed to an article including substrates bonded with a catalyzed metathesis polymer. Further, it is again noted that this reference, taken with the other applied art, provides evidence of the known application of metathesis polymers as *adhesives in general* with apparently broad applicability as well as the known fact that these polymers bond effectively to various materials including elastomer and metals, it being therefore prima facie obvious to utilize metathesis polymers anywhere an adhesive between materials is needed including in particular when metal and/or elastomer materials are to be bonded for only the expected results.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action (i.e. the change of the Suzuki rejection from based upon 102(b) alone to alternatively based upon 103). Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

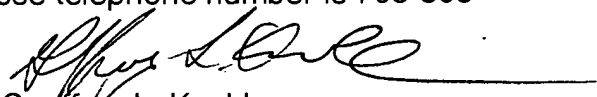
Art Unit: 1733

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
February 25, 2003